

Applicants: Charlotte Hauser-Funke
Application No. 09/913,631
Response

REMARKS

Applicant reserves the right to prosecute the subject matter of the non-elected claims in a divisional application, if such subject matter is not ultimately granted here.

Applicant hereby elects with traverse the species of (i) the blood clotting factor in claim 51 and (iii) the promoter sequences which comprise claims 59 and 90.

Regarding the traversal, the basis for the Examiner's restriction is under PCT Rule 13.1 for lack of Unity of Invention. The Examiner alleges that Groups I - III do not form a single inventive concept within Rule 13.2. According to PCT Administrative Rules (Annex B, Part I) "unity of invention exists only when there is a special technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features." The expression "special technical features" is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art.

Applicant refers the Examiner to Annex B in the MPEP entitled "Examples Concerning Unity of Invention", wherein numerous examples are provided to show unity of invention and the recited special technical feature in each example. Thus, by way of illustration, Example 6 in Annex B shows product, process and apparatus claims which share the "special technical feature common to all the claims is the tangential fuel injects". The Examiner found, at the bottom of page 2 of the Office Action dated September 9,

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2004, the special technical feature shared by Groups I and II is "a nucleic acid construct comprising an HRE and a transgene that are not functionally linked." The Examiner does not indicate Group III's relationship to the alleged "special technical feature". In the instant case, Applicants submit that the special technical feature shared by all of the claims in Groups I - III is the nucleic acid construct comprising at least one HRE and a transgene. Because the claims are directed to a nucleic acid construct, a method of preparing an agent for gene transfer using the nucleic acid construct, and a method of preparing an agent for treating hemophilia using the nucleic acid construct, they all share this special technical feature and thus unity of invention exists. Accordingly, Applicant submits the restriction is improper and request the restriction requirement to be withdrawn.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

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Early and favorable action is earnestly solicited.

Respectfully submitted,

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